

REMARKS

Reconsideration of the subject application is requested in view of the following remarks.

I. Claim Status

Claims 23, 24, 27, 29-34, 36, 40-63, and 65 have been canceled, without prejudice or disclaimer. Claims 1-22, 25, 26, 28, 35, 37-39, 64, and 66-85 are pending and at issue.

II. Anticipation Rejections**A. Rejections Under 35 U.S.C. § 102(e)**

Claims 1-22, 35, 64, and 66-82 remain provisionally rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Application Serial No. 10/719,553 (“the ‘553 application;” published as U.S. Publication No. 2004/0091500). According to the Examiner, the ‘553 application “discloses some of the same Bet v 1 mutants, disclosed in the current application.” This rejection is traversed on the grounds that the ‘553 application does not disclose the presently claimed invention.

The ‘553 application does not anticipate the present claims because it does not disclose every limitation of the claimed invention. MPEP § 2131.01 (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” citing *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the patent claim.” citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)).

$8 \times 7 \times 6 \times 5 = 1680$ different quadruple mutants. It is telling that of the 1680 possible Bet v 1 quadruple mutants, the Examiner points to only one quadruple mutant that has 4 primary mutations, each of which is more than 15 Angstroms apart. The Examiner derives this mutant, of course, from the instant application. In contrast to the mutants set forth in the instant application, the only quadruple mutant set forth in WO '680 does not meet the spacing requirement called for in the instant claims. Hence, contrary to the Examiner's position, it is not possible to "readily envisage" from the 1680 possible combinations of Bet v 1 quadruple mutants in the '680 application any mutant with at least 4 primary mutations, each of which is more than 15 Angstroms apart.

For at least the reasons set forth above, the present rejection should be withdrawn.

III. Obviousness-Type Double-Patenting Rejection

Claims 1-22, 35, 64, and 66-82 have been provisionally rejected under the judicially created doctrine of obviousness-type double-patenting over claims 36-96 of the '553 application. The Examiner alleges that the claims of the instant application are not patentably distinct from the claims of the '553 application ("the '553 claims"). The Applicants traverse this rejection.

"An obviousness-type double patenting rejection must be based on the obviousness standard of 35 U.S.C. 103(a)." MPEP § 1504.06, subsection II. The obviousness standard requires that the invention be considered as a whole (MPEP § 2141.02) and that there be a motivation to combine the references to arrive at the claimed invention (MPEP § 2143.01). The mere presence of elements of the claimed invention in the prior art is not sufficient to arrive at the claimed invention, even if it is possible to physically combine the elements.

The Examiner contends that the mutants claimed in the instant application are obvious over mutations set forth in claims 36-96 of the '553 application. The '553 claims, however, fail to render the instant claims obvious because they fail to suggest which four (at least), if any, of the mutations in the '553 claims should or could be combined to arrive at the instantly claimed invention. Nor is there any reasonable expectation of success that four mutations in the '553 claims could be combined to arrive at the instant claims. Contrary to a specific suggestion to arrive at the claimed invention that is required to find obviousness, the mere choice of elements from a large number of elements in the prior art to arrive at the presently claimed invention is an "obvious to try standard." MPEP § 2145, subsection X.B; *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988). "Obvious to try" is not the standard for obviousness. *Id.*

In view of the large number of possible quadruple mutants that could be formed using the mutations set forth in the '553 claims and the absence of any suggestion of to combine any particular set of mutants to arrive at the instantly claimed invention, the must have used the teachings of the instant specification modify the '553 claims and arrive at the instant claims. Such hindsight is not permitted. *ATD v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998). ("Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.")

For at least the reasons set forth above, claims 1-22, 35, 64 and 66-82 are not obvious over claims 39-96 of the '553 application. Reconsideration of claims 1-22, 35, 64, and 66-82 and withdrawal of the obviousness-type double-patenting rejection thereof is requested.

IV. Conclusion

In view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining, which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: January 17, 2006

Respectfully submitted,

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